

REMARKS

With this amendment, Applicants have amended claims 49, 52-55, 57, 58, 65, 67 and 92. Furthermore, Applicants have amended the specification for clarity. Upon entry of the present amendment, the pending claims will remain 49-94. No new matter has been added by way of the amendments to the claims or the specification.

This amendment responds to the December 28, 2004 Office Action. In the Office Action the Examiner:

- rejected claims 67-91 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- rejected claims 49, 52-55, 57-58 and 60-66 under 35 U.S.C. § 101 (first 101 rejection) because the claims are allegedly directed to non-statutory subject matter;
- rejected claims 67-91 under 35 U.S.C. § 101 (second 101 rejection) because the claims are allegedly directed to non-statutory subject matter;
- rejected claims 49-50, 54, 61-64, 66-72, 77, 85-88 and 90-93 under 35 U.S.C. § 102(b) as allegedly being anticipated by United States Patent 6,026,368 to Brown *et al.* (hereinafter "Brown");
- rejected claims 51, 57-59, 60, 65, 73, 81-84, 89 and 94 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown;
- rejected claims 52, 55-56, 74 and 78-80 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown as applied to claims 49 and/or 67, and further in view of United States Patent No 6,167,382 to Sparks (hereinafter "Sparks"); and
- rejected claims 53, 75 and 76 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown as applied to claims 59 and/or 74, and further in view of United States Patent No. 6,253,188 to Witek *et al.* (hereinafter "Witek")

THE 35 U.S.C. § 112 CLAIM REJECTION SHOULD BE WITHDRAWN

Claims 67-91. The Examiner has rejected claims 67-91 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner rejected claim 67 because the preamble includes a computer whereas software modules are recited in the body of the

claim. Claims 68-91 are rejected because they depend from claim 67. In response, Applicants have amended claim 67 to clarify that what is being claimed is a computer that has a memory, wherein the memory comprises specific software. In particular, the preamble of claim 67 has been amended to read “[a] computer comprising a memory, the memory comprising a self-serve user interface, wherein said self-serve user interface comprises.” In view of the amendment to claim 67, Applicants respectfully request that the 35 U.S.C § 112 rejection of claims 67-91 be withdrawn.

THE FIRST 35 U.S.C. § 101 REJECTION SHOULD BE WITHDRAWN

The Examiner has rejected claim 49 and dependent claims 52-55, 57-58 and 60-66 for allegedly being directed to non-statutory subject matter. In the office action, the Examiner suggested that this rejection could be overcome by amending the claims to better clarify which steps are being performed within the technological arts. Applicants have amended claim 49 and many of the rejected dependent claims to explicitly recite which steps are performed over a computer network and/or using a computer as suggested by the Examiner. Therefore Applicants respectfully request that the 35 U.S.C § 101 rejection of claims 49, 52-55, 57-58, and 60-66 be withdrawn.

THE SECOND 35 U.S.C. § 101 REJECTION SHOULD BE WITHDRAWN

The Examiner has rejected claims 67-91 for allegedly being directed to non-statutory subject matter. Applicants note that this rejection is related to the 35 U.S.C. § 112 rejection of claim 67-91 discussed above. In response to the 35 U.S.C. § 112 rejection, Applicants amended the preamble of claim 67 to read “a computer comprising a memory, the memory comprising a self-serve user interface, wherein said self-serve user interface comprises.” Because of this amendment, it is now clear that the instructions recited in claim 67 and its dependent claims are embodied in computer readable media in accordance with the Manual for Patent Examining Procedure, 2106 IV B 1 (a). Therefore, Applicants respectfully request that the 35 U.S.C § 101 rejection of claims 67-91 be withdrawn.

THE 35 U.S.C. § 102(b) REJECTION OF CLAIMS 49-50, 54, 61-64, 66-72, 77, 85-88 AND 90-93 SHOULD BE WITHDRAWN

The Examiner has rejected claims 49-50, 54, 61-64, 66-72, 77, 85-88 and 90-93 as allegedly being anticipated under 35 U.S.C. § 102(b) by Brown. Independent claims 49, 67, and 92 recite a maximum amount to spend on an advertisement campaign. In the Office Action, the Examiner rejected these claims over Brown despite the fact that the Examiner did not find this limitation in Brown. Likewise, inspection of Brown by Applicants reviewed no teaching of a maximum amount to spend on an advertisement campaign in Brown. However, the Examiner did not give this feature patentable weight because it was deemed by the Examiner to be non-functional data.

Applicants have amended claims 49, 67, and 92 to clarify the fact that the maximum amount to spend on an advertisement campaign is functional data that should be accorded patentable weight. Specifically, Applicants have amended claims 49, 67 and 92 to recite that the advertisement is displayed when the maximum amount to spend is not exceeded. Such a feature is noted throughout the specification including, for example, Fig. 5A and paragraph 52 on page 12 of the application as filed. As such, each of the rejected independent claims uses the maximum amount to spend on an advertisement campaign in a functional manner and is therefore patentable over Brown. The other rejected claims are patentable over Brown by virtue of the fact of their dependency to one of these amended independent claims.

For the above identified reasons, Applicants respectfully request that the 35 U.S.C § 102 rejection of claims 49-50, 54, 61-64, 66-72, 77, 85-88 and 90-93 be withdrawn.

THE 35 U.S.C. § 103(a) REJECTION OF CLAIMS 51, 57-59, 60, 65, 73, 81-84, 89 AND 94 SHOULD BE WITHDRAWN

The Examiner has rejected claims 51, 57-59, 60, 65, 73, 81-84, 89 and 94 under 35 U.S.C. § 103(a) as being unpatentable over Brown. As noted in the response to the 35 U.S.C. § 102(b) rejection above, claims 49 and 67 have been amended to recite that the advertisement is displayed when the maximum amount to spend is not exceeded. Claim 92 has been amended to recite instructions for incorporating an advertisement, when the advertisement campaign is accepted, into a web page when the maximum amount to spend is not exceeded. Brown does not teach or suggest these features. Thus, claims 49, 67, and 92 are patentable over Brown. Claims 51, 57-59, 60, 65, 73, 81-84, 89 and 94 are

patentable over Brown and by virtue of the fact that they ultimately depend from claims 49, 67, or 92.

Claims 65 and 89. Claims 65 and 89 are additionally patentable over Brown because Brown does not teach or suggest computing an effective cost per Mil (eCPM) for the advertisement. The Examiner states that the term “eCPM” is not specifically taught in the specification. The Examiner then incorrectly interprets the term eCPM as “cost per Mil.” The Examiner then asserts that it would have been obvious to modify Brown to use a “cost per Mil” metric to report to advertisers the effectiveness of an advertisement campaign.

Applicants traverse the rejection to claims 65 and 89 on additional grounds. As an initial matter, contrary to the Examiner’s assertions, the term eCPM recited in claims 65 and 89 is specifically defined in the specification. See at least paragraph 38 on page eight of the specification reproduced below:

Different pricing models can be directly compared by reducing the pricing to a common measure, for example the effective cost per thousand impressions (the eCPM). For a fixed price of \$x per impression, the $eCPM = \$x * 1000$. For a bid price of \$x per click-through, the $eCPM = \$x * \text{click-through-rate} * 1000$.

See also, paragraph 10 on page 4 of the specification, which states “[t]he eCPM can be calculated for example as $eCPM = CPC * CTR * 1000$, where CTR is the click-through rate.” Paragraph 10 defines CPC as “cost per click.” As such, paragraphs 10 and 38 each provide a consistent and clear definition of eCPM. Secondly, contrary to the Examiner’s assertions, the eCPM is not being used in claims 65 and 89 to “report to advertisers the effectiveness of the campaign.” The eCPM is used in claims 65 and 89 to decide which advertisement to place. In particular, claims 65 and 89 provide a displaying step that displays an advertisement when the eCPM for the advertisement *exceeds the eCPM of another advertisement*. Brown does not teach or suggest such a comparison. Nor would it have been obvious to modify Brown to make such a comparison.

For the above identified reasons, the 35 U.S.C. § 103(a) rejection of claims 51, 57-59, 60, 65, 73, 81-84, 89, and 94 should be withdrawn.

**THE 35 U.S.C. § 103(a) REJECTION OF CLAIMS 52, 55-56, 74 AND 78-80
SHOULD BE WITHDRAWN**

The Examiner has rejected claims 52, 55-56, 74, and 78-80 under 35 U.S.C. § 103(a) as being unpatentable over Brown as applied to claims 49 and/or 67, and further in view of Sparks. As noted in the response to the 35 U.S.C. § 102(b) rejection above, claims 49 and 67 have been amended to recite that the advertisement is displayed when the maximum amount to spend is not exceeded. Brown and Sparks, either alone or in combination, to not teach or suggest this feature. Thus, claims 49 and 67 are patentable over any combination of Brown and Sparks. Claims 52, 55-56, 74, and 78-80 are patentable over any combination of Brown and Sparks by virtue of the fact that they ultimately depend from claims 49 or 67. Therefore, Applicants' request that the 35 U.S.C. § 103(a) rejection of claims 52, 55-56, 74 and 78-80 be withdrawn.

**THE 35 U.S.C. § 103(a) REJECTION OF CLAIMS 53, 75, and 76
SHOULD BE WITHDRAWN**

The Examiner has rejected claims 53, 75, and 76 as being unpatentable under 35 U.S.C. § 103(a) over Brown as applied to claims 59 and/or 74, and further in view of Witek. Applicants traverse this rejection.

As noted in the response to the 35 U.S.C. § 102(b) rejection above, claims 49 and 67 have been amended to recite that the advertisement is displayed when the maximum amount to spend is not exceeded. Brown and Witek, either alone or in combination, to not teach or suggest this feature. Thus, claims 49 and 67 are patentable over any combination of Brown and Witek. Claims 53, 75, and 76 are patentable over any combination of Brown and Witek by virtue of the fact that they ultimately depend from claims 49 or 67.

Claims 53, 75, and 76 are patentable over the combination of Brown and Witek for additional reasons set forth below.

Claim 53 depends from claim 52, which, in turn, depends from claim 49. To reject claim 53, the combination of Brown and Witek must teach or suggest each limitation of claim 53 and each limitation of each claim from which the claim depends. The Examiner has rejected claim 49 under 35 U.S.C. § 102(b) as being anticipated by Brown. Applicants have overcome this rejection as discussed in the response to the 35 U.S.C. § 102(b) above. To reject claim 52, the Examiner relied on the combination of

Brown and Sparks. At a minimum, the Examiner must rely on the combination of Brown and Sparks to reject claim 53, since this combination was relied upon to reject a claim from which claim 53 depends.

Claims 75 and 76 ultimately depend from claim 74, which, in turn, depends from claim 67. To reject claims 75 and 76, the combination of Brown and Witek must teach or suggest each limitation of these claims and each limitation of each claim from which they depend. The Examiner has rejected claim 67 under 35 U.S.C. § 102(b) as being anticipated by Brown. Applicants have overcome this rejection as discussed in the response to the 35 U.S.C. § 102(b) above. To reject claim 74, the Examiner relied on the combination of Brown and Sparks. At a minimum, the Examiner must rely on the combination of Brown and Sparks to reject claims 75 and 76, since this combination was relied upon to reject a claim from which these claims depend.

Moreover, the Examiner asserts that Witek teaches providing a preview of the advertisement designated by a request as recited in claims 53, 75, and through dependency to claim 75, claim 76. This is simply not the case. Witek teaches a system for displaying classified advertisements to end-users. Witek does not teach previewing of advertisements by advertisers. Thus, the combination of Witek and Brown does not teach or suggest claims 53, 75 or 76.

For the above-identified reasons, the 35 U.S.C. § 103(a) rejection of claims 53, 75 and 76 should be withdrawn.

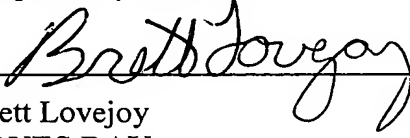
CONCLUSION

Applicants respectfully request that the foregoing amendments and remarks be entered and made of record in the file history of the subject application. Applicants believe that each ground for rejection has been successfully overcome or obviated, and that all the pending claims are in condition for allowance. Withdrawal of the Examiner's rejections and allowance of the application are respectfully requested.

It is believed that no fees are due in connection with the filing of this amendment other than the extension of time and fees for additional claims. However, should the United States Patent and Trademark Office determine otherwise, please charge the required fee to Jones Day deposit account no. 50-3013, referencing CAM No. 649388-999004.

Date: May 31, 2005

Respectfully submitted,


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